

**REMARKS**

In accordance with the foregoing, claims 1-2, 5, 7, and 11-15 are amended for form. No new matter is being presented, and approval and entry of the amended claims are respectfully requested. Claims 1-17 are pending and under consideration.

**ENTRY OF AMENDMENT UNDER 37 CFR §1.116**

Applicant requests entry of this Rule 116 Response because it is believed that the amendment of claims 1-2, 5, 7, and 11-15 puts this application into condition for allowance and should not entail any further search by the Examiner since no new features are being added or no new issues are being raised.

**FINAL STATUS OF ACTION MAILED MAY 18, 2004 IS PREMATURE AND SHOULD BE WITHDRAWN**

An Office Action mailed May 6, 2004 (previous Action) rejected claims 1-15 under 35 U.S.C. §112, second paragraph, as indefinite. The Examiner contended the claims "appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors." (Previous Action at page 2). The Examiner rejected claims 1-15 under 35 U.S.C. 103(a) as unpatentable over Herz (U.S.P. 6,460,036) in view of Kent (U.S. Pat. App. 2002/0040374).

To address the Examiner's concerns and in response to the 35 U.S.C. §112, second paragraph rejection, an Amendment filed August 6, 2004 amended claims 1-15 for form only to correct grammar.

The present, **final** Office Action (Current Action) now **finally** rejects claims 5, 6, 8, 10, and 12 under 35 U.S.C. 102(e) as being anticipated by **newly cited** art Nehab et al. (U.S. P. 6,029,182), and rejects claims 1-4, 7, 9, 11, and 13-15 under 35 U.S.C. 103(a) as being unpatentable over newly cited art Nehab.

In item 9 of the current Action, the Examiner indicates that "arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection."

Applicant submits that there is no action by Applicant, e.g., that amendment of claims 1-15 for form necessitated the new grounds of rejection to be made final. As set forth, for example, in MPEP 706.07(a):

(t)he applicant who is seeking to define his other invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.

Further, the Examiner has not indicated any grounds for making the current rejection citing new grounds of rejection as a final rejection. As such the current Action is also

incomplete. As set forth in MPEP §706.07(d):

(i)f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

### **Summary**

Applicant respectfully request withdrawal of the finality of the rejection as premature, and incomplete.

### **Traverse Of Rejections**

Applicant submits that Nehab is nonanalogous art and does not teach the features or advantages of present invention.

According to aspects of the present invention, a layout for displaying content data is designed fixedly by a provider of content data. The layout information generated by a provider of content data determines a manner in which information (e.g., headlines of reports ) are displayed , for example, in a style employed in a newspaper printout (see, for example, FIG. 12). Accordingly, a user by glancing at the displayed headlines can easily grasp a relative importance of parts of the content data associated with headlines. Thus, the user can select desired information. Thus, for example, since only reports corresponding to a selected headline, are distributed to a user terminal for display, a user can pay only for reports of which the headlines the user has selected.

Nehab, however, merely teaches allowing each user to customize, for example, a display layout of content data. (For example, Nehab is similar to a service such as "My Yahoo!" offered on a Yahoo site.)

### **ITEM 6: REJECTION OF CLAIMS 5, 6, 8, 10, AND 12 UNDER 35 U.S.C. §102(e) AS BEING ANTICIPATED BY NEWLY-CITED ART NEHAB**

The Examiner rejects claims 5, 6, 8, 10, and 12 under 35 U.S.C. §102(e) as being anticipated by newly-cited art Nehab.

Independent claims 5 and 8 recite respectively an information receiving method for externally receiving necessary information and a program, using claim 5 as an example, including "externally receiving information as headlines attached to respective information sets that may correspond to the received request and a way the information sets are handled in an information source as layout information; receiving an identity of a selected headline determined by a user according to the layout information; and externally requesting distribution of the information of the set corresponding to the headline the headline identity indicates."

Independent claim 12 recites an apparatus including "a layout information output unit externally receiving information as headlines attached to respective information sets that may

correspond to the request and a way the information sets are handled in an information source as layout information."

Applicant submits that Nehab does not teach features including "externally receiving information as headlines attached to respective information sets that may correspond to the received request and a way the information sets ~~is~~ are handled in an information source as layout information."

Rather, Nehab merely teaches (see for example col. 9, lines 27-33) that "extracted rules are now compiled to remove redundant links, multiple visits to the same site and the like."

Applicant also points out to the Examiner that claim 12 of the present invention is an independent apparatus claim. The Examiner rejects claim 12 indicating that "Nehab discloses a method." (Current Action at page 3)

### **Conclusion**

Since features recited by claims are not taught by Nehab, the rejection should be withdrawn and claims 5, 6, 8, 10, and 12 allowed.

### **ITEM 7: REJECTION OF CLAIMS 1-4, 7, 9, 11, AND 13-15 UNDER 35 U.S.C. 103(A) AS BEING UNPATENTABLE OVER NEHAB**

The Examiner rejects claims 1-4, 7, 9, 11, and 13-15 under 35 U.S.C. 103(a) as being unpatentable over Nehab.

Independent claims 1 and 7 recite a method and a program, respectively, using claim 1 as an example, including "receiving the request from the user terminal and. . . distributing to the user terminal the information of the set corresponding to the headline." Independent claim 2 recites a method including "receiving the request from the user terminal . . . and distributing to the user terminal information corresponding to the selected set."

Independent claim 8 recites a medium storing a program used to direct a computer in "receiving an identity of a selected headline determined by a user." Independent claims 11, 13, and 14 recite respectively an apparatus and a method using claim 11 as an example "receiving a request from the user terminal and . . . distributing information of a set corresponding according to the layout information to the user terminal." Independent claim 15 recites an apparatus including "a request output means for externally outputting a request for designation of possibly required information . . . ; and an information distribution means for distributing information of a set corresponding to the layout information to the user terminal."

The Action concedes that Nehab does not teach recited features included in each of the independent claims of a "user directly makes the request and designates the information to be used." (Current Action at pages 4-7). However, the Examiner contends that Nehab teaches:

the user must create the profile by designating preferences to filter information and specify web sites to get information . . . and thus it is obvious to have used the method of Nehab with the ability of allowing the user to make the requests directly because the use of a user profile was a well-known substitute for automatically making decisions (i.e. requests) for the user to save time.

(Current Action at pages 5-7).

Applicant submits that the Examiner's contention that "a user profile was a well-known substitute for automatically making decisions (i.e., requests) for the user to save time" is an unsupported taking of official notice. As set forth in MPEP § 2144.03:

(i)t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts . . . must always be supported by citation to some reference work recognized as standard in the pertinent art

Further, even if *arguendo* "a user profile was a well-known substitute for automatically making decisions" as the Examiner contends, a modification of Nehab by "automatically making decisions" does not teach the recited features.

#### **Conclusion**

Since features of the claims 1-4, 7, 9, 11, and 13-15 are not taught by the cited art and the taking of official notice is unsupported, *prima facie* obviousness is not established and the rejection should be withdrawn and claims 1-4, 7, 9, 11, and 13-15 allowed.

#### **CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: February 3, 2005

By: Paul W. Bobowiec  
Paul W. Bobowiec  
Registration No. 47,431

1201 New York Ave, N.W., Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501